



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,670	10/05/2001	Hiroyuki Ikeda	24806	2000

20529 7590 02/22/2005

NATH & ASSOCIATES
1030 15th STREET, NW
6TH FLOOR
WASHINGTON, DC 20005

EXAMINER

HALIM, SAHERA

ART UNIT PAPER NUMBER

2157

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,670

Applicant(s)

IKEDA ET AL.

Examiner

Sahera Halim

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/17/03, 9/16/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1, 6, 10, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Reference to claims 1 and 10, the claims recite "an input unit for preparing relevant addressee information to which a second record medium is to be delivered,...". It is unclear how a second record medium is delivered to an input unit. For examination purposes it is read as an input unit for preparing relevant addressee information, which is to be delivered to a second record medium.

Appropriate clarification of the claim is required.

- b. Reference to claims 6, 14 and 15, the claims recite, " preparing relevant addressee information to which said a second record medium is to be delivered". Again it is unclear how second record medium is delivered to preparing relevant addressee information. For examination purpose it is read as preparing relevant addressee information to be delivered to a second record information.

Appropriate clarification of the claim is required.

Art Unit: 2157

In addition, claim 6, recites the limitation "said a second record medium " in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. It is assumed as a second record medium.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4 -15 are rejected under 35 U.S.C. 102(e) as being anticipated by Powers, U.S Pat. No. 6,446,115 (hereinafter Powers).

6. Regarding claim 1 Powers teaches a record media delivery system comprising (abstract):

an information transmitting section including a readout unit for reading out record information recorded in a first record medium, an input unit for preparing relevant addressee information to which a second record medium is to be delivered, and a transmitting unit for transmitting said record information and said relevant addressee information via a communication network (col. 5, line 21 - 56;

Art Unit: 2157

Powers teaches generating completed mail objects from email or text messages from registered senders to be received by recipient in remote locations in hard copy, a server means for receiving a correspondence message, a database comprising recipient information and addresses and a remote facility for generating hard copy correspondence at a location facilitating rapid delivery to the recipient using exiting delivery services).

a delivery media recording section including a receiver unit for receiving said record information and said relevant addressee information from said information transmitting section via said communication network (Internet), and an output unit for recording said record information on said second record medium, adding said relevant addressee information to said second record medium and outputting said second record medium (col. 5, line 29 – 64; Powers teaches a remote facility for generating hard copy correspondence. The hard copy correspondence is sent to the recipient by facsimile transmission to the recipient fax number).

7. As to claim 2, Powers teaches the record media delivery system according to claim 1, further comprising:

a memory unit for storing database that keeps said relevant addressee information (col. 5, line 34 –39, Powers teaches databases comprising recipient information and addresses); and
a server for interconnecting said information transmitting section and

Art Unit: 2157

said delivery media recording section via said communication network (col. 5, lines 29 –33, a computer or server means).

8. Reference to claim 4, Powers teaches the record media delivery system according to claim 2, wherein said first and second media include a postal card (col. 7, line 9-15), said readout image scanner (col. 8, line 8 – 11) and said outputting unit includes a printer (Fig 3c, numeral 53 and col. 19, line 33 – 48).

9. As to claim 5, Powers discloses the record media delivery system of claim 1, wherein said communication network include the Internet (Fig. 1, numeral 16).

10. Claim 6, has similar limitations as to claim 1, therefore it is rejected under the same rational.

11. Reference to claim 7, Powers discloses the record media delivery method according to claim 6, further comprising: reading out information of an address card described with more than or equal to one delivery destination, referring to information of said address card and preparing said relevant addressee information (col. 9, line 56 – col. 10, line 49).

12. Claim 8, has the same limitations as to claim 3, thus it is rejected under same rational as claim 3.

Art Unit: 2157

13. Claim 9 has the same limitations as to claim 5, therefore, claim 9 is rejected under the same rational as to claim 5.

14. Claim 10 has similar limitations as to claim 1, thus it is rejected under the same rational as claim 1.

15. Claims 11 and 12 have similar limitations as to claims 4 and 5, thus they are rejected under the same rational.

16. Reference to claim 13, Powers discloses the information transmission device according to claim 10, wherein said relevant addressee information include a category of said second record medium (col. 19, line 33 – 48).

17. Claims 14 and 15 have similar limitations as to claim 1 and they do not further teach or differ over the limitations. Therefore, claims 14 and 15 are rejected under the same rational as to claim 1.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 2157

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Power. Although the system disclosed by Powers shows substantial features of the claimed invention, it fails to teach said server unit keeps information related to a delivery status of said second record medium. Nonetheless this feature is old and well known in the art and it would have been an obvious modification to the system disclosed by Powers. It would have been obvious for a person having ordinary skill in the relevant art at the time of the invention to save delivery status information in order to control network traffic by enabling the users know the statuses of their requests before transmitting the same data over and over again.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,870,718 to Spector

U.S. Pat. No. 5,765,141 to Spector

U.S. Pat. No. 6,778,988 to Bengton

U.S. Pat. No. 6,700,677 to Onodera et al.

U.S. Pat. No. 6,209,097 to Nakayama et al.

U.S. Pat. No. 6,778,289 to Iwata

Art Unit: 2157

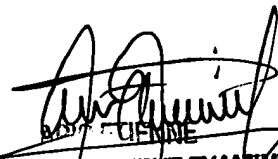
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim
Patent Examiner
AU: 2157

February 11, 2005


Ario Etienne
SUPERVISOR
PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100